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Supreme Court, U.S.
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No. 03-1187

IN THE

Supreme Court of the United States

ALLOC, INC., BERRY FINANCE N.V.
and VÄLINGE INNOVATIONS, AB,
fka VÄLINGE ALUMINUM, AB,

Petitioners,

v.

INTERNATIONAL TRADE COMMISSION, and
PERGO, INC., and ROYSOL, and
AKZENTA PANEELE + PROFILE GMBH,
and UNILIN FLOORING N.V.,
BHK OF AMERICA, INC. and
MEISTER-LEISTEN SCHULTE, GMBH,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION FOR COMPANY RESPONDENTS

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QUESTIONS PRESENTED

I. Has the Federal Circuit properly articulated the well-settled principles of law governing when it is appropriate to refer to the specification and file history in construing a claim?

II. Did the Federal Circuit properly apply these well-settled principles to the facts in this case?

RULE 29.6 STATEMENT

Respondent Unilin Flooring N.V. (formerly known as Unilin Décor N.V.) states that Unilin Industries, N.V. is the parent corporation of Unilin Flooring N.V.. No publicly-held company owns 10 percent or more of Unilin Flooring N.V..

Respondent BHK of America, Inc. states that BHK Germany is the parent corporation of BHK of America, Inc. and that no publicly-held company owns 10 per cent or more of the stock of BHK of America, Inc..

Respondent Meister-Leisten Schulte GmbH states that it has no parent company and that no publicly-held company owns 10 per cent or more of its stock.

Respondent Pergo, Inc. states that Pergo, Inc. is wholly-owned by the Dutch company Pergo Holding B.V.. No publicly-held company owns 10 per cent or more of the stock of Pergo, Inc..

Respondent Akzenta Paneele + Profile GmbH states that W. Classen GmbH & Co. KG, a publicly traded company, is the parent company of Akzenta Paneele + Profile GmbH.

Respondent Roysol states that The Roysol Group is the parent company of Roysol and that no publicly-held company owns 10 per cent or more of the stock of Roysol.

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Andrew T. Zidel, *Patent Claim Construction in the Trial Courts: A Study Showing the Need for Clear Guidance from the Federal Circuit*, 33 Seton Hall L. Rev. 711 (2003) 11

Alloc's petition presents no general legal issue meriting review. There is no division within the Federal Circuit over the principles of law regarding the proper use of a patent's specification and file history in claim construction. Those principles fully respect the claim-based system for defining inventions and inevitably call for patent-specific inquiries. Moreover the Federal Circuit's articulation and application of these principles in this case was correct. Petitioner's challenge to the decision presents only case-specific issues not appropriate for review by this Court.

COUNTER-STATEMENT OF THE CASE

I. Background

Petitioners Alloc, Inc., Berry Finance, N.V., and Välinge Innovation AB (collectively, "Alloc") filed a complaint under Section 337 of the Tariff Act of 1930, 19 U.S.C. § 1337, in the International Trade Commission (the "ITC") on December 4, 2000. Petition for Certiorari ("Pet.") at 2. The complaint charged that the Company Respondents infringed three Alloc patents relating to mechanically-locking floor panels.[1] Appendix to Petition ("Pet. App.") at 5a. After a hearing, the administrative law judge (the "ALJ") issued a Final Initial Determination of non-infringement. *Id.* at 72a-322a. The ALJ

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1. U.S. Patent Nos. 5,860,267 (the " '267 patent"), 6,023,907 (the " '907 patent"), and 6,182,410 (the " '410 patent"). Pet. App. 5a. The three asserted patents share an identical specification and claim priority from the same Patent Cooperation Treaty ("PCT") application and a continuation of this application, issued as U.S. Patent No. 5,706,621 (the " '621 patent"). *Id.* The '907 and '267 patents are method patents. Pet. at 4.

construed all the asserted claims of the patents[2] to include a limitation requiring "play," a small space, in the joint between floor panels and, because none of the accused products had play, concluded that there was no infringement. *Id.* at 86a-193a.

Alloc and the ITC Investigative Staff appealed to the ITC. *Id.* at 44a. The ITC issued a Notice of Final Determination of No Violation of Section 337 on March 22, 2002 and an Opinion on the Issues under Review on April 11, 2002. Pet. at 2-3. The ITC adopted much of the ALJ's claim construction, including the construction requiring play in the joints. Pet. App. at 11a.

Alloc appealed to the Federal Circuit. *Id.* That court affirmed the ITC decision on September 10, 2003 and denied Alloc's petition for rehearing and rehearing *en banc* on November 17, 2003. *Id.* at 2a, 27a. On February 17, 2004, Alloc filed a petition for a writ of *certiorari*.

II. The Federal Circuit's Claim Construction

The Federal Circuit Court of Appeals began by reciting the familiar principles that "the claims define the scope of an invention" (citing *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc)) and "'[c]laim language generally carries the ordinary meaning of the words in their normal usage in the field of invention'" (quoting *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1367 (Fed. Cir. 2003)). Pet. App. at 11a, 12a. The court noted that reference to the specification, prior art, and other evidence is proper "to discern the context and normal usage of [the]

2. The asserted claims are: claims 1, 2, and 3 of the '907 patent; claims 19, 23, and 39 of the '267 patent; and claims 1, 26, 41, and 48 of the '410 patent. Pet. at 4.

words in [a patent] claim." *Id.* at 12a. (citing, e.g., *Hoechst Celanese Corp. v. BP Chems., Ltd.*, 78 F.3d 1575, 1579 (Fed. Cir. 1996)). Further, the majority observed that "a patent applicant may consistently and clearly use a term in a manner either more or less expansive than its general usage in the relevant art, thereby expanding or limiting the scope of the term in the context of the patent claims." *Id.* (citing *Middleton, Inc. v. Minn. Mining & Mfg. Co.*, 311 F.3d 1384, 1388 (Fed. Cir. 2002), and *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1342 (Fed. Cir. 2001)).

As to the role of the specification, the court reiterated the well-established need to respect both of two cautions: one against reading limitations appearing only in the specification into claims that carry a plain broader meaning; the other requiring that claims be construed in light of the specification. Pet. App. at 16a. The court also invoked the familiar notion that how those principles apply in a particular case "turns on how the specification characterizes the claimed invention." *Id.* (citing *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1305 (Fed. Cir. 2003)). The court explained that, while "it is impermissible to read the one and only disclosed embodiment into a claim without other indicia that the patentee so intended to the limit the invention" (citing *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327 (Fed. Cir. 2002)), "it is entirely permissible to limit claims . . . where the specification makes clear at various points that the claimed invention is narrower than the claim language might imply." *Id.* (citing *SciMed*, 242 F.3d at 1345)).

Contrary to Petitioner's assertion that the court below "essentially ignored" the language of the claims, that court began its claim construction by setting out the words of certain representative claims and underlining the disputed

terms in each. Pet. at 17; Pet. App. at 6a-10a. These terms, which include "locking element," "displacing," "locking member," "locking means," and "displacement," relate to the structure of the Alloc floor panels and the method by which the panels are joined. Pet. App. at 6a-10a.

In interpreting the claim terms, the court concluded that the specification required play in every embodiment of the invention. Pet. App. 13a-17a. The specification described "the invention" (rather than a particular embodiment of the invention) as a system in which "a play exists" when the panels are joined together.[3] *Id.* at 13a. Figure 1 includes a Δ symbol, indicating play, and the description of figure 1 recites that there was play in the joint to allow mutual displacement

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3. The court cited the following text from the common specification in support of this conclusion:

> '[T]he *invention* . . . provid[es] a system for making a joint along adjacent joint edges of two building panels, especially floor panels . . . said system being characterized in that . . . the panels, when joined together, can occupy a relative position in said second direction *where a play exists* between the locking groove and a locking surface on the locking element that is facing the joint edges and is operative in said second mechanical connection.'

"'[T]he *objects of the invention* are achieved by means of a panel-joining system having the features recited in the appended claims.'"; and "'*The above and other features and advantages of the invention* will appear from the appended claims and the following description of the embodiments of the invention.'" Pet. App. 13a (emphasis added).

when the panels were joined together.[4] *Id.* at 14a. The specification recites that play permitted disassembly and reassembly,[5] and reiterates that the floor panel's second mechanical connection included play to permit the panels to be disassembled.[6] *Id.* at 14a-15a. Finally, the specification criticizes prior art floor systems without play and nowhere describes or depicts an embodiment without play. *Id.* at 15a.

The prosecution history clearly confirmed that "play is a key feature of the claimed invention." *Id.* at 18a-21a.

4. The cited text of this description reads,

> when the panels 1 and 2 are joined together, they can however occupy such a relative position in the direction D2 that there is a small play DELTA between the locking surface 10 and the locking groove 14. This mechanical connection in the direction D2 allows mutual displacement of the panels 1, 2 in the direction of the joint, which considerably facilitates the laying and enables joining together the short sides by snap action.

Pet. App. 14a.

5. Here, the text in the specification recited that the panels can be disassembled by the preferred method "even if the aforementioned play between the locking groove and the locking surface is not greater than 0.2 mm." Pet. App. 14a.

6. The cited text provides that the "invention" includes a second mechanical connection in which "a play exists between the locking groove and a locking surface on the locking element that is facing the joint edges and is operative in said second mechanical connection." The specification also recites that the second mechanical connection "is so conceived as to allow the locking element to leave the locking groove if the groove panel is turned about its joint edge angularly away from the strip." Pet. App. 14a-15a.

The International Preliminary Examination Report in the Patent Cooperation Treaty application — from which the patents asserted in this case claim priority — "based its conclusion of novelty on the claim's recitation of play in the system joint." *Id.* at 18a. The patentee represented to the United States Patent and Trademark Office (the "PTO"), during the prosecution of the '621 patent (the parent to the patents asserted here), that play was "important" because it allowed for displacement and disassembly. *Id.* The PTO examiner allowed certain claims of the '621 patent over a prior art reference on the basis that the prior art did *not* allow for displacement. *Id.* at 19a. And the patentee represented, after winning allowance because its invention permitted displacement, that certain amended claims, while not including the word "play," nonetheless described an invention that included play and, "'*as such*,'" permitted displacement. *Id.* at 19a-20a (emphasis added).

REASONS FOR DENYING THE PETITION

I. The Federal Circuit has properly articulated the well-settled principles governing the use of the specification and file history in claim construction.

Petitioner attempts to manufacture an issue meriting review by arguing that the law on the proper use of the specification in construing patent claims is in "disarray," that there is "confusion" regarding the use of the specification and file history in claim interpretation, and that the Federal Circuit's articulation and application of these principles represents a "deviation from the claims-based system." Pet. at 9, 17, 22. Petitioner is wrong on all points.[7]

7. Petitioner argues that this purported confusion leads to uncertainty as to the scope of claims which "is manifesting itself in (Cont'd)

The principles governing the proper use of a patent's specification and prosecution history in construing claims are well-settled and easily summarized. To ascertain the meaning of claims, the court considers three sources: the claims, the specification, and the prosecution history. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) ("*Markman I*"), *aff'd*, 517 U.S. 370 (1996) (quoting *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1561 (Fed. Cir. 1991)). Claim construction begins with the words of the claim. *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1324 (Fed. Cir. 2002).[8] Claim terms generally

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the extraordinary rate of reversal on claim interpretation." Pet. at 9. However, one of the two authors cited explicitly refutes this contention. *See* Christian A. Chu, *Empirical Analysis of the Federal Circuit's Claim Construction Trends*, 16 Berkeley Tech. L.J. 1075, 1097 (2001) (Concluding that the high reversal rate is primarily a function of the application of the *de novo* review standard and noting that,

> [i]n *Markman I*, the Federal Circuit stated that the construction of patent claims starts with the claim language, as interpreted in light of the specification and the prosecution history. Since 1995, it has invoked and applied that approach consistently and reliably . . . Over time, claim construction should thus become more predictable and consistent.

8. Petitioner ignores the *Teleflex* case, when, in support of its charge that the law is unsettled, it cites to Judge Dyk's concurrence in *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337, 1347 (Fed. Cir. 2001), which called on the Federal Circuit to provide additional guidance on proper claim construction. *Teleflex*, decided a year after *SciMed*, includes a lengthy

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take their ordinary meaning, if there is one. *Id.* at 1325. But claims must be read in view of the specification, which "may act as a sort of dictionary, explaining the invention and defining terms used in the claims." *Markman I*, 52 F.3d at 979. The prosecution history has also long been recognized as a vital source for the proper construction of claims, both for the light it sheds on interpreting terms in need of clarification and for its role in disclaiming otherwise-broader interpretations in order to secure the patent from the PTO. *Id.* at 980 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966), and *Autogiro Co. v. U.S.*, 384 F.2d 391, 397 (Fed.Cir. 1967)); *see Teleflex*, 299 F.3d at 1326. Thus, "ordinary meaning" does not control a claim term's construction where, for example, the patentee sets forth a definition of the disputed claim term in either the specification or prosecution history; the specification or file history shows that the patentee limited the scope of the claims (by distinguishing prior art on the basis of a particular feature, expressly disclaiming subject matter, or describing a particular embodiment as important to the invention); the claim term deprives the claim of meaning such that a definite meaning can be determined only by reference to the specification and file history; or the claim is phrased in step- or means-plus-function format. *CCS Fitness, Inc. v. Brunswick Corp.*, 288

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discussion of this issue which greatly clarified existing law. *See* Gregory J. Gallagher, *The Federal Circuit and Claim Construction: Resolving the Conflict Between the Claims and the Written Description*, 4 N.C.J.L. & Tech. 121, 142 (2002) (*Teleflex* "articulate[s] a comprehensive standard" on the relative roles of the claims and specification, which "provides the appropriate amount of protection to [] patentee[s] while providing incentive for innovation" and, over time, will lead to greater certainty in claim construction).

F.3d 1359, 1366-67 (Fed. Cir. 2002). These principles are long-established.[9]

Contrary to petitioner's contention, these principles are in full accord with this Court's pronouncements on claim construction. It has long been established that "an invention is construed not only in light of the claims, but also with reference to the file wrapper or prosecution history . . . Claims as allowed must be read and interpreted with reference to rejected ones and to the state of the prior art." *Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966). More recently, this Court in *Markman v. Westview Instruments, Inc.*, holding that

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9. These are venerable principles which the Federal Circuit has repeatedly expounded. *See Autogiro Co. v. U.S.*, 384 F.2d 391 (Fed. Cir. 1967); *Renishaw PLC v. Marposs Societa' Per Azioni*, 158 F.3d 1243 (Fed. Cir. 1998); *Phillips Petroleum Co. v. Huntsman Polymers Corp.*, 157 F.3d 866 (Fed. Cir. 1998); *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985 (Fed. Cir. 1999); *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547 (Fed. Cir. 1997); *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996); *Amhill Enters. Ltd. v. Wawa, Inc.*, 81 F.3d 1554 (Fed. Cir. 1996); *Modine Mfg. Co. v. U.S. Int'l Trade Comm'n*, 75 F.3d 1545 (Fed. Cir. 1996); *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565 (Fed. Cir. 1983); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572 (Fed. Cir. 1984); *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753 (Fed. Cir. 1984); *Caterpillar Tractor Co. v. Berco S.p.A.*, 714 F.2d 1110 (Fed. Cir. 1983); *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182 (Fed. Cir. 1998); *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430 (Fed. Cir. 1988); *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323 (Fed. Cir. 2001); *All Dental Prodx, LLC v. Advantage Dental Prods., Inc.*, 309 F.3d 774 (Fed. Cir. 2002); *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336 (Fed. Cir. 2001); *Innovad Inc. v. Microsoft Corp.*, 260 F.3d 1326 (Fed. Cir. 2001); *DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314 (Fed. Cir. 2001); *Apple Computer, Inc. v. Articulate Sys.*, 234 F.3d 14 (Fed. Cir. 2000).

judges, not juries, should construe claims, relied critically on the settled principle that claim construction entails a "necessarily sophisticated analysis of the whole document," so that terms are defined to "comport [ ] with the instrument as a whole." 517 U.S. 370, 389 (1996). Still more recently, in *Festo Corp. v. Shiketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002), the Court approved the context-specific principles of claim construction laid out in *Autogiro*, 384 F.2d at 397.

Petitioner contends that, by acknowledging the role of the specification and prosecution history in claim construction, the Federal Circuit has deviated from the claims-based system by "expand[ing] the relative weight" of the specification, "inflat[ing] the importance" of the prosecution history and "diminish[ing] the relative importance of the claims." Pet. at 11, 22. But this Court's decisions, as just noted, and the long line of decisions in the Federal Circuit and its predecessor courts, make clear that the claims are *not* undervalued when the specification and prosecution history are examined in just the ways the Federal Circuit did in this case. As the Federal Circuit explained in *Eastman Kodak Company v. Goodyear Tire & Rubber Company*, 114 F.3d 1547, 1552 (Fed. Cir. 1998), "a construing court does not accord the specification, prosecution history, and other relevant evidence the same weight as the claims themselves," but refers to these sources to give the claim language its proper context. *See also Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 957 (Fed. Cir. 1983) ("That claims are interpreted in light of the specification does not mean that everything in the specification must be read into all the claims."); *SRI Int'l*, 775 F.2d at 1121 (the specification and file history are useful but the focus remains on the claims).

Petitioner's refusal to recognize virtually any role for the specification and file history in claim construction may be why Petitioner concludes that there is "inconsistency" in the Federal Circuit's application of its claim construction principles and that certain Federal Circuit rulings are "without any articulable legal justification."[10] Pet. at 11-12. The fact that particular specifications and prosecution histories have greater or lesser weight in different cases is simply the result of the fact that the inquiry as to the meaning of claims is inevitably context-specific. The process of claim interpretation — the "sophisticated analysis of the whole document" called for by this Court's decision in *Markman* — is, of necessity, an intensely context-specific exercise. The Federal Circuit has explained the unavoidable patent-specificity of the inquiry: "Whether an invention is fairly claimed more broadly than the 'preferred embodiment' in

10. In support of its "inconsistency" charge, Petitioner cites to a group of articles, all of which offer explanations for the high rate of reversal in patent cases. Several of the cited articles do not argue that the Federal Circuit's application of its claim construction principles is inconsistent. In fact, the thesis of one is that the Federal Circuit has given proper guidance on the issue. *See* Gregory J. Gallagher, *The Federal Circuit and Claim Construction: Resolving the Conflict Between the Claims and the Written Description*, 4 N.C.J.L. & Tech. 121 (2002). Others attribute the high reversal rate to poor claim construction by district court judges. *See* Andrew T. Zidel, *Patent Claim Construction in the Trial Courts: A Study Showing the Need for Clear Guidance from the Federal Circuit*, 33 Seton Hall L. Rev. 711 (2003) (rate of reversal primarily due to the poor construction skills of trial judges which would be improved by educating these judges as to how claims are drafted); Kimberly A. Moore, *Are District Court Judges Equipped to Resolve Patent Cases?*, 15 Harv. J.L. & Tech. 1, 38-39 (2001) (recommends that expedited appeals process or system of specialized courts be established to take claim construction out of the hands of unskilled district court judges).

the specification is a question specific to the content of the specification, the context in which the embodiment is described, the prosecution history, and if appropriate the prior art." *Teleflex*, 299 F.3d at 1327. *See also*, *e.g.*, *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186-87 (Fed. Cir. 1998) ("there is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification").

The Federal Circuit, speaking through Judge Bryson, recently explained the established principles and the inherent patent-specificity of their application. *Liebel-Flarsheim Co. v. Medrad, Inc.*, Nos. 03-1082, 03-1165, 2004 WL 241482 (Fed. Cir. Feb. 11, 2004). The court explained that the requirement to read claims in light of the specification and the prohibition against reading a limitation from the specification into a claim are the "twin axioms" of claim construction. *Id.* at 5. It added that, while "parties frequently cite one or the other [axiom] . . . as if [it] were sufficient, standing alone, to resolve [] claim construction issues," the "axioms themselves seldom provide an answer, but instead merely frame the question to be resolved." *Id.*

Petitioner's argument rests on its mistaken insistence on crediting only one of the "twin axioms" with validity as a principle of claim construction, and virtually ignoring the specification and prosecution history. This Court, however, has long held otherwise; so, too, has the Federal Circuit. While the particular application of the principles sometimes provokes disagreements — as does the particular application of statutory-construction principles — there is no need or warrant for this Court to review the principles of claim construction regularly being applied in the Federal Circuit.

II. The Federal Circuit's application of well-settled principles of law to the facts of this case was correct.

Petitioner also attempts to cast the court of appeals' claim construction in this case — a necessarily context-specific inquiry — as an issue meriting review. Petitioner's main argument is that the court below accorded too much weight to the specification and prosecution history. Pet. at 17. This argument fails because the majority properly applied correct principles of claim construction in reaching a decision. Petitioner then makes a variety of miscellaneous complaints relating to the Federal Circuit's claim construction, none of which are meritorious.

The court below started its claim construction by setting out non-controversial rules of construction and then properly interpreted the claims, reviewing the specification in order to determine what the claim terms meant in context and, in particular, whether the inventors had limited the claims to make clear that play in the joints was required. The court concluded that the specification described the "invention" rather than a single embodiment as including a play limitation.[11] Pet. App. at 13a-15a. The court also properly

11. In support of its claim that certain Federal Circuit decisions on claim construction are "without any articulable legal justification," Petitioner cites to the views of a single commentator, Robert L. Harmon. Pet. at 11-12. However, in quoting Mr. Harmon, Petitioner excised one important sentence (without indicating that any text had been removed). The full quote follows with the portion omitted by Petitioner italicized.

> *Cautionary note.* Despite the Federal Circuit's repeated protestations to the contrary, the author has come to the

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examined the prosecution history to see whether it comported with that interpretation. Finding that the prosecution history did confirm its determination, the court held that the claims included a play limitation. *Id.* at 22a. This method of analysis is perfectly consistent with this Court's principles of claim construction. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996).

Petitioner complains that the court below violated one tool of claim construction: the "claim differentiation" principle, which cautions against finding a limitation in one claim where the limitation exists in another claim. Pet. at 18-19. Here, a "play" limitation is present in terms in

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> belief that sometimes it does in fact import limitations from the specification into the claims. In other words, it limits the claim coverage to the embodiment described in the specification without any articulable legal justification. *In certain cases, the author has been entirely unable to discern a clear indication, in the patent documents, that the preferred embodiments has [sic] been described "as the invention itself," or to see how a person skilled in the art would understand that the inventor intended such a limitation. And yet the claims have been construed to be limited to that embodiment.*

Pet. App. at 489a-490a. The sentence that Petitioner omitted is important because, in this case, the Federal Circuit, in contrast to the approach condemned by Mr. Harmon, expressly relied on the fact that the specification repeatedly describes "the invention" (rather than a particular embodiment) as having play. Pet. App. 13a. Thus, even if Mr. Harmon's theory is correct, the decision in this case, is *not* a decision "without any articulable legal justification," the court below was correct in holding that the Alloc claims include a play limitation, and review is inappropriate.

claim 49 of the '410 patent – which was not asserted in this case. Pet. at 18. Even in general, however, it has long been recognized that the doctrine of claim differentiation is only one tool of construction, often not determinative, because it is common for patentees to seek multiple ways of capturing the same invention. *Fromson v. Anitec Printing Plates, Inc.*, 132 F.3d 1437, 1445 (Fed. Cir. 1997) ("this doctrine cannot, of itself, restore to [the patentee's] claims a scope that has been shown to be unwarranted"). *See Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1538 (Fed. Cir. 1991) (quoting *Autogiro*, 384 F.2d at 404) ("Claim differentiation is a guide, not a rigid rule. If a claim will bear only one interpretation, similarity will have to be tolerated."). *See, e.g., Tandon Corp. v. U.S. Int'l Trade Comm'n*, 4 U.S.P.Q.2d 1283, 1288 (Fed. Cir. 1987) (affirming the ITC's claim construction, which found a limitation in a one claim despite the limitation's presence in another, on the basis of the ITC's finding that the specification and prosecution history required so limiting the claim); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1269 (Fed. Cir. 1986) (interpreting independent claim to include a limitation even though limitation was present in dependent claim because interpretation was "clearly consonant with the implications of the rest of the patent and the intent of the patentee"); *Kraft Foods, Inc. v. Int'l Trading Co.*, 203 F.3d 1362, 1368 (Fed. Cir. 2000) (doctrine of claim differentiation overcome by specification and prosecution history).

In fact, the case that Petitioner cites, *D.M.I., Inc. v. Deere & Co.*, 755 F.2d 1570 (Fed. Cir. 1985), recognizes the limitations of the claim-differentiation doctrine and its inapplicability in circumstances like those presented here. Specifically, *D.M.I* points out that application of the doctrine may not be appropriate where, as here, the prosecution history

shows reliance on a narrow construction to obtain the patent in the PTO. *Id.* at 1575. Here, the court of appeals, given the compelling evidence supporting the inclusion of the play requirement (based on the specification and prosecution history), was not required to reject that construction because claim 49 uses "play" language expressly.

The balance of Petitioner's arguments hinge on its mischaracterization of the decision below, which disregards the court's careful exposition of the bases on which it ruled. First, citing to *Smith v. Snow*, 294 U.S. 1 (1935), Petitioner argues that the court of appeals, when finding a play requirement in the two method claims at issue, impermissibly construed method claims as being limited to the particular disclosed apparatus. Pet. at 19-20. This contention is just another version of Petitioner's blinkered view of claim construction. In *Snow*, the invention was a method for incubating chicken eggs using heated air, and there was no basis in the claim for restricting the method to a particular arrangement of the eggs, or means of guiding the heated air around them, shown in the specification: "neither [element was] requisite to the application of the principle which Smith discovered and claimed." 294 U.S. at 11. Here, "displacement" was part of Alloc's claims to a method of connecting floor panels, and the court below properly held, in construing that language, that play was required to achieve displacement. Pet. App. 15a.

Second, Petitioner contends that the court of appeals improperly limited the claims of its patents to the best mode as depicted in the specification; petitioner invokes the rule that the inventor is not limited to the mode depicted in the specification and argues that a contrary position "punishes the inventor for complying with [the best mode requirement]."

Pet. at 22. Again, Petitioner's argument mischaracterizes the decision below, and the claim-construction principle as well. The court below expressly and correctly stated the rule as proscribing courts from reading "the one and only disclosed embodiment into a claim *without other indicia that the patentee so intended to limit the claim.*" Pet. App. 16a (citing *Teleflex*, 299 F.3d at 1327) (emphasis added). The court of appeals, as detailed above, properly based its decision on a range of indicia, found in both the specification and the file history, that signaled that the invention was narrower than the claim language might imply. *See* Pet. App. 13a-21a.

In sum, Petitioner's efforts to fashion an issue deserving of review by challenging the Federal Circuit's analysis in this case is unsuccessful. The decision below was correct and resulted from proper application of well-established principles of claim construction. In any event, Petitioner's complaints relate only to patent-specific interpretation issues and are not appropriate for review by this Court.

CONCLUSION

For the reasons set out above, the Petition should be denied.

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